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EXAMINER

ORWIG, KEVIN S

ART UNIT

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/528,698	<b>Applicant(s)</b> FERRARI ET AL.	
	<b>Examiner</b> Kevin S. Orwig	<b>Art Unit</b> 1611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 September 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 65-146 is/are pending in the application.
- 4a) Of the above claim(s) 137-146 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 65-136 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>9/21/06, 1/7/08</u> .   | 6) <input type="checkbox"/> Other: _____                          |

**DETAILED ACTION*****Status of the Claims***

Claims 65-146 are currently pending. Claims 65-136 are the subject of this Office Action. This is the first Office Action on the merits of the claims. Non-elected claims 137-146 are withdrawn from consideration.

***Election/Restrictions***

Applicants' election of Group I (claims 65-136) in the reply filed on May 29, 2008 is acknowledged. In response to applicant's election, Group II (claims 137-142), Group III (claims 143 and 144), and Group IV (claims 145-146) are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicants have elected Group I with traverse.

The traversal is on the ground(s) that the restriction requirement does not comply with proper unity of invention practice and that the prior art cited in the restriction requirement does not break unity. This traversal is not found to be persuasive because there are four inventions, one drawn to a lip makeup composition, one drawn to a cosmetic assembly, one drawn to a cosmetic process, and one drawn to a method for making a lip makeup composition. Group I exists in an intermediate/final product relationship with Group II. Additionally, Group I is drawn to a different statutory category of invention (a composition of matter) than Groups III and IV, which are drawn to methods. The

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inventions are not so closely related as to depend absolutely upon one another and are therefore patentably distinct.

Applicants allege that the technical feature incorporated in each of the Groups was not identified. However, the common technical feature among the inventions was identified in the restriction requirement of May 1, 2008 as being a lip makeup composition (see page 2, paragraph 2, lines 3-4). Applicants allege that the international preliminary examination report (IPER) indicates that unity of invention exists. It is noted that the USPTO is not bound by the findings of the international searcher. Nonetheless, the IPER states that "the invention as defined in at least some of the claims does not appear to meet the criteria mentioned in Article 33(1) PCT, i.e. does not appear to be novel and/or to involve an inventive step". If an invention lacks novelty and/or an inventive step, a special technical feature cannot be present since such an invention does not provide a contribution over the prior art. Thus, the IPER actually supports the finding of a lack of unity in this case.

Applicants further allege that U.S. Patent 6,153,206 (ANTON) does not teach every limitation of the claims. While it is acknowledged that Anton does not disclose a resistive index, the limitation "when it is present in a sufficient amount in the composition, the lip makeup composition *can* form a deposit that has a resistive index of greater than or equal to 80%" is not required for the common technical feature. Furthermore, a property such as "resistive index" is an inherent characteristic of a given compound, and would be necessarily present in the compositions of Anton. The limitation states that when it is present

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in a sufficient amount, a composition can form a deposit that has a resistive index of greater than or equal to 80%. When present in a sufficient amount, the compositions of Anton would be capable of fulfilling this requirement, thus meeting the limitations of the claim.

Therefore, the restriction requirement is still deemed proper and is therefore made FINAL.

In the reply of May 29, 2008, applicants elected the following species:

Monomer structure: isobornyl (methyl)acrylate

Additional monomer: acrylic acid

It is noted that "isobornyl (methyl)acrylate" is taken to be "isobornyl (meth)acrylate". It is conventional in the art to indicate an *optional* methyl group with parentheses in the name. Thus, the elected species encompasses both isobornyl methacrylate and isobornyl acrylate.

Claim 89 is drawn to a composition comprising a polymer having two blocks, one of which has a  $T_g$  less than or equal to 20°C (recited in claim 89) and the other of which has a  $T_g$  of between 20°C and 40°C. Since one block must comprise isobornyl (meth)acrylate per the species election, this must be the block with a  $T_g$  of greater than or equal to 40°C, thus the remaining block according to claim 83 has a  $T_g$  of between 20°C and 40°C, and therefore cannot have a  $T_g$  of less than or equal to 20°C. Claim 89 is therefore withdrawn as being drawn to a non-elected species.

***Priority***

The earliest effective U.S. filing date afforded the instantly claimed invention has been determined to be Sep. 26, 2003, the filing date of PCT application PCT/FR03/02843 to which the instant national stage 371 application claims priority. Acknowledgment is made of applicant's claim to foreign priority under 35 U.S.C. 119(a)-(d). The certified copies of the French applications were filed with the USPTO on Mar. 22, 2005.

***Information Disclosure Statement***

References lined-through on the information disclosure statement(s) were not considered because they were not provided or were not provided in English.

***Claim Objections***

Claim 95 is objected to because of the following informalities: the word "an" in the next to last line of the claim should be "and".

Appropriate correction is required.

***Claim Rejections - 35 USC § 112 (2<sup>nd</sup> Paragraph)***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**Claims 79-82, 84, 85, 87, 88, 90, 91 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.** These claims recite the limitation of various percentages of the

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blocks "by weight of the polymer relative to the total weight of the composition". This limitation is unclear since there appear to be two bases upon which the recited percentages are relative. For example, claim 79 recites "wherein the proportion of the at least one first block ranges from 20% to 90% by weight of the polymer relative to the total weight of the composition." It is clear from this claim that the percentage of the first block is relative to the weight of the polymer. Therefore, it is unknown how this percentage could also be relative to the total weight of the composition. The situation is analogous for claims 80-82, 84, 85, 87, 88, 90, and 91. This limitation is not defined by the claim, the specification does not provide a sufficient standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. Thus, one of ordinary skill in the art would not know to what standard the percentages must be relative. Since one of ordinary skill in the art could not be expected to make a reasonable distinction in the absence of further definitions and/or guidance in the specification, the metes and bounds of these claims are indefinite.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 65-69, 114-124, 126-128, and 130-136 are rejected under 35 U.S.C. 102(b) as being anticipated by ANTON (U.S. Patent No. 6,153,206; Issued Nov. 28, 2000; Reference # 35 on IDS dated Sep. 21, 2006).**

1. Anton discloses cosmetic compositions comprising an oil component and a synthetic ethylenic block polymer (abstract; column 2, lines 9-23; claim 1). Anton teaches that one repeating unit (i.e. block) is preferably constructed from isobornyl methacrylate (elected species) (column 4, lines 5-27; Example 1). Anton teaches that the oil component is a volatile or nonvolatile oil (i.e. an organic liquid medium) (column 6, lines 8-10 and 17-19). Anton teaches that the compositions are useful as transfer resistant lipsticks (column 1, lines 65-67; Example 1).

2. Anton does not measure the resistive index of the compositions. It is noted that "resistive index" is a measurement of the transfer resistance of the composition as evidenced by paragraphs [0014]-[0026] of the instant specification, wherein a sample of the composition (on a support) is pressed onto white paper and moved through deposits of oil and water and the deposit remaining on the support is measured after this process. While Anton does not measure the transfer resistance of the compositions in such a specialized assay, it is an object of Anton's lipstick compositions to provide high transfer resistance (column 1, line 65 to column 2, line 3; Example 1). Thus, it is reasonable that the transfer resistant lipstick compositions taught by Anton (e.g. Example 1) would be *capable* of having a resistive index of greater than or equal to 80%, 85%, or



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95% when present in a sufficient amount, which is all that is required by instant claims 65-68.

3. The U.S. Patent Office is not equipped with analytical instruments to test prior art compositions for the infinite number of ways that a subsequent applicant may present previously unmeasured characteristics. When, as here, the prior art appears to contain the exact same ingredients and applicant's own disclosure supports the suitability of the prior art composition as the inventive composition component, the burden is properly shifted to applicant to show otherwise.

4. Regarding the limitations "styrene-free" in claims 65 and 114, and the limitation "non-elastomeric" in claims 66 and 119, Anton teaches styrene-free transfer resistant lipsticks (Example 1) and teaches the use of the same monomer components of the block polymers as those instantly claimed. Thus, the compositions of Anton are both styrene-free and non-elastomeric. Therefore, Anton anticipates instant claims 65-68, 114, and 119.

5. Regarding claim 69, Anton does not disclose the solubility of the block polymers, but teaches the use of the same monomer components of the block polymers as those instantly claimed (see below). Therefore, it is reasonable that the polymers taught by Anton will not be soluble at an active material content of at least 1% by weight in water, and thus meet the limitations of claim 69.

6. Anton teaches that the molecular weight average of the polymer is from 5,000 to 300,000, but is preferably from 5,000 to 50,000 (column 5, lines 23-28). Anton exemplifies a composition comprising a polymer having a molecular weight of 27,100 (Example 1), reading on instant claims 115-118.

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7. Anton teaches that the preferred compositions comprise from 3-30% of the copolymer (column 11, line 10), and embodies the copolymer in the range of 19-20% by weight of the composition (Example 1), reading on claims 120 and 121.

8. As discussed above, Anton teaches that the oil component is a volatile or nonvolatile oil and exemplifies 6% isododecane in the transfer resistant lipstick composition (Example 1), reading on claims 122-124.

9. Anton also teaches that the nonvolatile oil may be a hydrocarbon-based oil (column 7, lines 44-45) or nonvolatile silicone oil (column 7, line 54-67). Anton exemplifies 8% of the nonvolatile oil fluoro octyldodecyl meadowfoamate (Example 1), reading on claims 126-128.

10. Anton teaches that the preferred compositions of the invention comprise 1-30% of a wax (column 9, lines 41-49; column 11, lines 8-21), and exemplifies a composition comprising 7% synthetic wax (Example 1), reading on claims 130-132.

11. Anton also teaches that the compositions include dyestuffs (column 9, lines 17-20; see Example 1, wherein D&C and FD&C lakes are dyestuffs), reading on claim 133.

12. Anton teaches that it is desirable to add other ingredients such as preservatives, antioxidants, vitamins, eumulsifiers (i.e. surfactants) and the like (column 11, lines 5-7). Furthermore, Anton teaches that the compositions most preferably contain additional shine enhancers, which are polymers with high

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refractive index (column 11, lines 22-24) and exemplifies compositions containing fragrances (Example 1), reading on claim 134.

13. Anton teaches the composition in the form of an anhydrous stick (column 2, lines 24-36 and 40-42; claim 19), reading on claims 135 and 136.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

**Claims 65-74, 77-88, 90-136 are rejected under 35 U.S.C. 103(a) as being unpatentable over Anton in view of GALLEGUILLOS (U.S. 6,410,005; Issued Jun. 25, 2002).**

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14. Anton anticipates instant claim 65 as discussed above. Anton further teaches that the polymer of the invention may be a copolymer, a terpolymer (i.e. a polymer of three different monomers), or have any number of different units in addition to the first and second repeat units (i.e. blocks) (column 2, lines 58-62; column 4, lines 28-60). In particular, Anton teaches block terpolymers and teaches that the repeating units are monomer units which are present more than one time in the polymer chain and can be present in either repetitive sequence or in random sequence with other monomer units (column 3, lines 21-24). Anton also emphasizes the importance of having "hard" and "soft" portions (i.e. portions having different glass transition temperatures,  $T_g$ ) in the polymer to maintain both flexibility and shine of the composition (column 2, lines 51-58). Anton does not embody the instantly claimed architecture with sufficient specificity to be anticipatory.

15. However, Galleguillos discloses AB block copolymers for cosmetic use on keratin substrates (column 1, lines 12-14) comprising soft hydrophobic and hard hydrophilic blocks with two or more distinct glass transition temperatures, represented by Structures 1 and 2 (column 4, lines 44-65). Specifically, Galleguillos discloses a process of polymerizing a polyfunctional monomer X within the scope of the instant intermediate block constituent (see column 4, structures 1 and 2) with a first ethylenically unsaturated monomer(s) to form an A block, and subsequently polymerizing a second ethylenically unsaturated monomer(s) containing at least one carboxylic acid group with the A block to form a B block, and the resultant block copolymer (column 3, lines 53-60; column

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4, lines 18-43; column 5, lines 2- 4; column 6, line 27 to column 7, line 57). Thus, a copolymer containing blocks of  $-(B)_p-X-(B)_q-$ , and  $-(A)_n-A-X-A-(A)_n-$  is formed, wherein X is a multifunctional monomer that links the A and B blocks. The linkage of X-X reads on the instant intermediate block, wherein X is also a constituent monomer of the A and B blocks in  $-(B)_p-X-(B)_q-$ , and  $-(A)_n-A-X-A-(A)_n-$ . Absent of specific compositional and architectural details claimed for the instant intermediate block, prior art  $-B-X-X-A-$  linkages in structures 1 and 2 fall within the scope of the instant intermediate block as both blocks A and B contain at least one constituent X, as defined in the present claims.

16. Galleguillos teaches the weight percent of each of the monomers in the mixture can vary, depending on the desired properties of the final copolymer product and teaches that these properties can be tailored by varying the composition and length of the blocks (column 4, lines 38-39; column 13, lines 1-2). Galleguillos specifically discloses using varying proportion of mixtures of A and B monomers so as to achieve the desired balance of the resultant block polymer properties (column 12, lines 12-15; column 13, lines 1- 8).

17. In light of these teachings, it would have been *prima facie* obvious to one of ordinary skill in the art at the time of the invention to prepare a polymer arranged with a first block and a second block connected by an intermediate block comprising both types of monomers, to provide a suitable polymer compound. One would have been motivated to do so since the teaching of Anton suggests such an arrangement, and since one of ordinary skill in the art would recognize that including a block comprising monomers from the "hard" and

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"soft" portions provides an additional means (besides the weight % of each block) to manipulate the overall properties of the polymer, as taught by Galleguillos. Further, it is well within the skill of ordinary artisan to select the appropriate properties of a copolymer for a given formulation. Therefore if an artisan wanted to produce a polymer with both high flexibility and shine qualities, one would have been motivated to arrange the "hard" and "soft" polymer blocks such that they were connected by an intermediate block as suggested by Anton and taught by Galleguillos. Thus, the combination of Anton and Galleguillos renders claim 70 obvious.

18. Anton teaches that the first repeat unit has a  $T_g$  of about  $-10-75^{\circ}\text{C}$  and the second repeat unit has a  $T_g$  of about  $76-120^{\circ}\text{C}$  (abstract; column 4, line 62 to column 5, line 1). Specifically, Anton embodies a polymer comprising blocks of isobornyl methacrylate ( $T_g = 110^{\circ}\text{C}$ ) and isobutyl methacrylate ( $T_g = 53^{\circ}\text{C}$ ) (Example 1) and teaches that a variety of other monomers are useful in the polymers, for instance n-butylmethacrylate ( $T_g = 20^{\circ}\text{C}$ ), hexyl methacrylate ( $T_g = -5^{\circ}\text{C}$ ) (column 3, line 56 to column 4, line 38; column 5, lines 33-54, see the second table in column 5). Thus, it would be obvious to an ordinary artisan to use any combination of these monomers rendering claims 71, 72, 77, 78, 83, 86, 92-99 obvious.

19. Regarding claim 73, it is reasonable that a block comprising monomers from each of a "hard" and "soft" block will have a  $T_g$  between these two extremes, as would be recognized by the ordinary artisan. For example, Anton teaches that the overall  $T_g$  of the polymer lies between that of the isolated "hard"

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and "soft" segments (abstract; column 2, lines 13-23). Thus, given the teachings of Anton, claim 73 is rendered obvious.

20. Regarding claim 74, Anton does not disclose the compatibility of the various polymer blocks, and does not disclose the solubility of the blocks in the major organic liquid medium of the composition, which is how mutual incompatibility is defined in the instant specification (paragraph [0042]). Nonetheless, since Anton discloses substantially the same composition to that instantly claimed, including the same types of monomers, and blocks thereof, it is reasonable that these blocks are mutually incompatible as defined in the instant specification. Thus, claim 74 is rendered obvious by Anton and Galleguillos.

21. It is noted that there is an issue of indefiniteness with claims 79-82, 84, 85, 87, 88, 90, 91. For the purposes of this rejection, the percentages are interpreted to be relative to the weight of the polymer. Anton teaches that relative to the polymer, the portions of the first and second repeat units can vary from 2-99% by weight of the first repeat unit to 1-98% by weight of the second repeat unit and vice versa (column 5, lines 3-32). Thus, it would be obvious to an ordinary artisan to use any percentage within this range for each of the blocks. As discussed above, both Anton and Galleguillos teach that manipulating the percentages of the blocks alters the properties of the final polymer. Thus, the skilled artisan would be motivated to do so to optimize the properties of the polymer for a particular formulation. Therefore, the combination of Anton and Galleguillos renders claims 79-82, 84, 85, 87, 88, 90, and 91 obvious.

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22. Anton teaches a variety of monomers useful for the various polymer blocks of the polymer (column 3, line 56 to column 4, line 27; second table in column 5). In particular, Anton teaches 2-ethylhexylmethacrylate ( $T_g = -10^\circ\text{C}$ ), which is encompassed by the formulas of methacrylates (i.e. alkyl acrylates) recited in instant claims 100 and 101. As stated above, it would be *prima facie* obvious to an ordinary artisan to use any combination of these monomers as defined by the teachings of Anton, rendering claims 100 and 101 obvious. Furthermore, as discussed above, Anton teaches block terpolymers and teaches that the repeating units are monomer units which are present more than one time in the polymer chain and can be present in either repetitive sequence or in random sequence with other monomer units (column 3, lines 21-24). Furthermore, Anton describes polymer architectures comprising homopolymeric blocks (column 4, lines 28-60), as does Galleguillos (column 4, structures 1 and 2). Thus, it would have been obvious to an ordinary artisan to produce a polymer having homopolymeric blocs of any of the monomers taught by Anton, such as 2-ethylhexylmethacrylate, rendering claims 102 and 103 obvious.

23. As stated above, Anton teaches n-butylmethacrylate ( $T_g = 20^\circ\text{C}$ ) in addition to other monomers useful in the blocks of the invention in addition to isobornyl methacrylate (column 3, line 56 to column 4, line 38; column 5, lines 33-54, see the second table in column 5), thus claim 104 is obvious over Anton and Galleguillos.

24. Anton teaches block polymers of various configurations containing blocks of differing  $T_g$  values. Anton teaches (and exemplifies) polymers wherein one



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block comprises isobornyl methacrylate, which has a high  $T_g$  (Example 1). The other block may comprise monomers that, if polymerized, have much lower  $T_g$  values. These other monomers include 2-ethylhexylmethacrylate ( $T_g = -10\text{ }^{\circ}\text{C}$ ). As discussed above, per the teachings of Galleguillos, it would have been obvious to produce a block polymer having a block A comprising isobornyl methacrylate, a block B comprising 2-ethylhexylmethacrylate, and an intermediate block comprising each monomer. This type of polymer encompasses that claimed in instant claims 105 and 106.

25. Regarding claims 107 and 108, it is noted that Applicants have elected the species acrylic acid and have stated that this species reads on claim 108. Since acrylic acid does not contain a silicon atom, it is therefore presumed that acrylic acid is a hydrophilic monomer. Anton teaches a variety of monomers useful for the various polymer blocks of the polymer (column 3, line 56 to column 4, line 27; second table in column 5). As stated above, it would be *prima facie* obvious to an ordinary artisan to use any combination of these monomers as defined by the teachings of Anton. Furthermore, as discussed above, Anton teaches block terpolymers and teaches that the repeating units are monomer units which are present more than one time in the polymer chain and can be present in either repetitive sequence or in random sequence *with other monomer units* (column 3, lines 21-24). Furthermore, Anton describes polymer architectures comprising at least three different monomers (column 4, lines 28-60) and teaches that the final polymer may contain, in addition to the first and second repeat units, other monomeric units such as ethylenically unsaturated monomer units and silicon

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repeat units. Thus, it would have been prima facie obvious to an ordinary artisan at the time of the invention to include such an additional monomer (in addition to isobornyl methacrylate and, for example 2-ethylhexylmethacrylate), in the polymer as taught by Anton. While Anton teaches methacrylic acid and esters thereof, acrylic acid itself is not disclosed.

26. However Galleguillos discloses that both methacrylic acid and acrylic acid are preferred monomers in the block polymers of the invention (column 8, lines 39-41 and 63-67; column 11, line 27). One of ordinary skill in the art would be motivated to substitute acrylic acid for methacrylic acid due to the similarities of these compounds and since Galleguillos establishes them as functional equivalents. Thus, the artisan would have a high expectation of success by substituting one functional equivalent for another, rendering claims 107-110 and 112 obvious.

27. While Anton does not disclose the weight % of the additional monomer relative to the first and/or second blocks, it is the examiner's position that it would be well within the skill of the ordinary artisan to adjust the amount of the additional monomer based on the teachings of Anton (see upper table in column 5). One would be motivated to adjust the amount of the additional monomer for the reasoning presented above regarding the intermediate block, which is to achieve the optimal and desired properties of the polymer through manipulation of the types and configurations of the monomers therein as taught by both Anton and Galleguillos. Thus, claim 111 is obvious over these references.

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28. Anton teaches block terpolymers and teaches that the repeating units are monomer units which are present more than one time in the polymer chain and can be present in either repetitive sequence or in random sequence with other monomer units (column 3, lines 21-24). Furthermore, Anton describes polymer architectures comprising homopolymeric blocks (column 4, lines 28-60), as does Galleguillos (column 4, structures 1 and 2). Thus, it would have been obvious to an ordinary artisan to produce a polymer having homopolymeric blocs of any of the monomers taught by Anton, as well as the functional equivalents taught by Galleguillos, such as acrylic acid, rendering claims 113 obvious.

29. Anton anticipates claims 122-124 as discussed above. However, Anton does not embody a lip makeup composition comprising a volatile oil in an amount ranging from 10-35% with sufficient specificity to be anticipatory. However Anton teaches that the preferred composition comprises a volatile oil in the range of 10-40% (column 11, lines 8-21). Thus, it would be obvious to use a volatile oil in this range as taught by Anton, rendering claim 125 obvious.

30. Anton anticipates claims 126-128 as discussed above. However, Anton does not embody a lip makeup composition comprising a nonvolatile oil in an amount ranging from 20-50% with sufficient specificity to be anticipatory. However Anton teaches that the preferred composition comprises a nonvolatile oil in the range of 10-30% (column 11, lines 8-21). Thus, it would be obvious to use a nonvolatile oil in this range as taught by Anton, rendering claim 129 obvious.

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A reference is good not only for what it teaches by direct anticipation but also for what one of ordinary skill in the art might reasonably infer from the teachings. (*In re Opprecht* 12 USPQ 2d 1235, 1236 (Fed Cir. 1989); *In re Bode* 193 USPQ 12 (CCPA) 1976). In light of the forgoing discussion, the examiner concludes that the subject matter defined by the instant claims would have been obvious within the meaning of 35 USC 103(a). From the teachings of the references, it is apparent that one of ordinary skill in the art would have had a reasonable expectation of success in producing the claimed invention. Therefore, in the absence of evidence to the contrary, the invention as a whole was *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references.

**Claims 65-88 and 90-136 are rejected under 35 U.S.C. 103(a) as being unpatentable over Anton in view of Galleguillos as applied to claims 65-74, 77-88, 90-128, and 130-136 above, and in further view of RAETHER (U.S. 2004/0014872; Filed Jun. 13, 2001; Reference #13 on IDS dated Sep. 21, 2006).**

31. Regarding claims 75 and 76, neither Anton nor Galleguillos disclose the polydispersity of the polymers of their inventions. However, Anton clearly teaches that a molecular weight between 5,000 to 50,000 is advantageous (column 5, lines 23-28). Thus, it is the examiner's position that it would have been obvious and fully within the purview of one having ordinary skill in the art to control the optimum molecular weight, polydispersity, polymer composition and

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architectures of the resultant block copolymer product by varying experimental parameters such as source, amount, and solvation of catalyst/initiators/control agents, polymerization temperature and time, etc., as taught by the references referred to by Anton (column 5, line 64 to column 6, line 6).

32. The ordinary artisan would have been motivated to select a polydispersity in the range of 3.0 because Raether discloses a composition comprising block polymers useful for cosmetics (abstract; paragraph [0092]; claim 13) and teaches that a preferred polydispersity for such polymers is between about 3-5 (paragraph [0019]) for polymers comprising multiple segments, such as those taught by Anton and Galleguillos. Thus, the combined teachings of Anton, Galleguillos, and Raether render claims 75 and 76 obvious.

A reference is good not only for what it teaches by direct anticipation but also for what one of ordinary skill in the art might reasonably infer from the teachings. (*In re Opprecht* 12 USPQ 2d 1235, 1236 (Fed Cir. 1989); *In re Bode* 193 USPQ 12 (CCPA) 1976). In light of the forgoing discussion, the examiner concludes that the subject matter defined by the instant claims would have been obvious within the meaning of 35 USC 103(a). From the teachings of the references, it is apparent that one of ordinary skill in the art would have had a reasonable expectation of success in producing the claimed invention. Therefore, in the absence of evidence to the contrary, the invention as a whole was *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

### **U.S. Patent Application No. 10/529,264**

Claims 65-136 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-56 of copending Application No. 10/529,264. Although the conflicting claims are not identical, they are not patentably distinct from each other because the scope of the '264 claims renders obvious that of the instant claims. The difference between the two claim sets is that the '264 claims recite that the composition is capable of forming a deposit that has a transfer of less than or equal to 35%, while the instant claims recite a composition that can form a deposit that has a resistive index of greater than or equal to 80%. Both of these limitations are drawn to the transfer resistance of the composition, and indicate that each is to resist transfer. Since each application recites the same monomer components and architecture, in the absence of evidence to the contrary, it is reasonable that the compositions claimed in the '264 application would meet the instant limitation. It is noted that '264 claim 23 recites the elected species of

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isobornyl (meth)acrylate and claim 36 recites acrylic acid, the elected species for the additional monomer. Thus, the scope of the two claim sets is substantially identical, and the entire scope of the instant claims is rendered obvious over the '264 claims.

U.S. Patent Application No. 10/528,835

Claims 65-136 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 85-155 of copending Application No. 10/528,835. Although the conflicting claims are not identical, they are not patentably distinct from each other because the scope of the '835 claims renders obvious that of the instant claims. The difference between the two claim sets is that the '835 claims recite a gelling agent and do not include a limitation regarding resistive index. However, since resistive index is an inherent property of a given polymer and since each application recites the same monomer components and polymer architecture, in the absence of evidence to the contrary, it is reasonable that the compositions claimed in the '835 application would meet the instant resistive index limitations. Further, it is noted that instant claim 130 recites the addition of gums, which are suitable gelling agents according to the '835 claims. Additionally, '835 claim 97 recites the elected species of isobornyl (meth)acrylate and claim 138 recites acrylic acid, the elected species for the additional monomer. Thus, the scope of the two claim sets is substantially identical, and the entire scope of the instant claims is rendered obvious over the '835 claims.

U.S. Patent Application No. 10/529,266

Claims 65-136 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 77-163 of copending Application No. 10/529,266. Although the conflicting claims are not identical, they are not patentably distinct from each other because the scope of the '266 claims anticipates or renders obvious that of the instant claims. The difference between the two claim sets is that the '266 claims recite that the composition has a mean gloss of greater than or equal to 30 out of 100 and that the transfer index is less than or equal to 40 out of 100. The latter limitation is drawn to the transfer resistance of the composition, and indicates that the composition is to resist transfer, as is the case with the instant claims. Regarding the limitations of a mean gloss value, the gloss of a lipstick formulation would be optimized by the skilled artisan. As taught by Anton, the "hard" portions of the polymers taught are responsible for shine of the polymer. Thus, it would be obvious to an ordinary artisan to optimize the gloss of the lipstick formulation. Since each application recites the same monomer components and architecture, in the absence of evidence to the contrary, it is reasonable that the compositions claimed in the instant application would meet the '266 limitation. It is noted that '266 claim 117 recites the elected species of isobornyl (meth)acrylate and claim 154 recites acrylic acid, the elected species for the additional monomer. Thus, the scope of the two claim sets is substantially identical, and the entire scope of the instant claims is rendered obvious over the '266 claims.



U.S. Patent Application No. 10/529,218

Claims 65-136 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 80-165 of copending Application No. 10/529,218. Although the conflicting claims are not identical, they are not patentably distinct from each other because the scope of the '218 claims anticipates or renders obvious that of the instant claims. The difference between the two claim sets is that the '218 claims recite that the composition has a mean gloss of greater than or equal to 30 out of 100. Regarding the limitations of a mean gloss value, the gloss of a lipstick formulation would be optimized by the skilled artisan. As taught by Anton, the "hard" portions of the polymers taught are responsible for shine of the polymer. Thus, it would be obvious to an ordinary artisan to optimize the gloss of the lipstick formulation. Since each application recites the same monomer components and architecture, in the absence of evidence to the contrary, it is reasonable that the compositions claimed in the instant application would meet the '218 limitation. It is noted that '218 claim 97 recites the elected species of isobornyl (meth)acrylate and claim 135 recites acrylic acid, the elected species for the additional monomer. Thus, the scope of the two claim sets is substantially identical, and the entire scope of the instant claims is rendered obvious over the '218 claims.

***Conclusion***

No claims are currently allowable.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin S. Orwig whose telephone number is (571)270-5869. The examiner can normally be reached Monday-Friday 7:00 am-4:00 pm (with alternate Fridays off). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sharmila Landau can be reached Monday-Friday 8:00 am-5:00 pm at (571)272-0614. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

KSO

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